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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,957	04/19/2000	Eric C. Perlin	MSI-385US	3826

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EXAMINER

KENDALL, CHUCK O

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/551,957

Applicant(s)

PERLIN ET AL.

Examiner

Chuck O Kendall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-43, 45-47 and 49 is/are rejected.
- 7) ☒ Claim(s) 44 and 48 is/are objected to.
- 8) ☒ Claim(s) 41-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) / ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is in response to the application filed 05/31/01.
2. Claims 41-49 have been examined.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-40, drawn to an integrated circuit card with debugging ability, classified in class 714, subclass 38.
- II. Claims 41-49, drawn to an application development tool for use with a debugger, classified in class 717, subclass 124.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombination disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. Each respective invention has utility as in a system not having the other. See MPEP § 806.05(d).

During a telephone conversation with Lewis Lee Reg. 34,656 on 10/29/2003 a provisional election was made without traverse to prosecute the invention of Group II, claims 41-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 41-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett USPN 6,173,419.

Regarding claim 41, Barnett anticipates, an application development system comprising:

a computer system to execute an application within an application development tool (2:1-10); and

a smart card incorporating a smart card development interface, coupled to the -- computer system, to receive and identify debug frames interlaced with application frames within a normal communication flow between the application executing on the computer system and the smart card, wherein the smart card development interface promotes the application frames to an application layer of the smart card, and invokes debug features of the smart card in response to debug instructions embedded within the received debug frames (Col. 5 lines 37 to 60).

Regarding claim 42, an application development system according to claim 41, wherein the computer system further comprises:

a client development interface (fig 7, item # 118), to interlace debug frames generated by the application development tool with application frames generated by the application executing within the application development tool.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43 - 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett USPN 6,173,419 in view of Jacobson USPN 6,195,774.

Regarding claim 43, Barnett discloses all the claimed limitations as applied in claim 42 above. Barnett doesn't expressly disclose wherein the application development tool generates debug frames in response to user interaction with the application development tool. However, Jacobson doesn't show this functionality in a similar environment (Jacobson, Col. 21, lines 37 to line 40). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Barnett and Jacobson because, using interfaces to interact with users makes the system more automated and thus more efficient.

Regarding claim 45, an application development system according to claim 43, wherein the debug frames invoke and control one or more smart card resources facilitating debugging of the application executing within the application development tool of the computer system (5:35-50).

Claims 43 - 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett USPN 6,173,419 as applied in claims 41 and 42, in view of You et al. USPN 5,787,245 (hereinafter You).

Regarding claim 46 & 47, Barnett discloses all the claimed limitations as applied in claim 42 above. Barnett doesn't explicitly disclose, wherein the client development

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interface includes a debug filter to identify and route debug frames received from the smart card. However, You does disclose this feature (4:35-39). Therefore it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine Barnett and You because, using filters to identify and route debug data ensures that the data reaches it's respective locations, hence making the system more dynamic.

Regarding claim 49, an application development system according to claim 41, further comprising:

a communication protocol, employed by the computer system and the smart card to communicate there between, the communication protocol comprising;

a plurality of application frames comprising a normal communication flow between a host application and a smart card application (Barnett, fig 2); and

one or more debug frames, interlaced with the application frames within the normal communication flow, to enable a debug application executing on the host system to selectively access and control smart card resources (Barnett, fig 6, 108,104).

Allowable Subject Matter

Claims 44 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art doesn't teach or render obvious to the following:

"... wherein the application development tool populates a source and/or destination field of the debug frame with an invalid source and/or destination address".

Correspondence Information

6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Chuck O. Kendall who may be reached via telephone at (703) 308-6608. The examiner can normally be reached Monday through Friday between 8:00 A.M. and 5:00 P.M. est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached at (703) 305-4552.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

For facsimile (fax) send to central FAX number 703-872-9306 and 703-7467240 draft.

Chuck O. Kendall

Software Engineer Patent Examiner
United States Department of

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